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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/353,670 07/15/99 PRELL

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EXAMINER

HM22/0925

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WILSON, T

ART UNIT

PAPER NUMBER

1623

DATE MAILED:

09/25/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/353,670

Applicant(s)

Prell

Examiner

James O. Wilson

Group Art Unit

1623



☒ Responsive to communication(s) filed on Sep 20, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-16 is/are pending in the application.

Of the above, claim(s) 1-3 and 7-16 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 4-6 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Applicant's election of Group II, claims 4-6 in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-3 and 7-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6-8 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The distinct steps for the "regulation of biological activity" critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

The examiner notes that the steps of the instant invention involve "contacting" an imidazoline receptor with imidazoleacetic acid ribotide, riboside or riboside cogener, however, the specification does not provide a sufficient definition for the term "contacting". It is further noted that the identity of the biological function to be regulated relative to imidazoline receptors in the "method of regulation" is not seen to be set forth in full, clear and exact terms. In any event,

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the specification does not enable a single step method for regulating biological activities in imidazoline receptors via a single step process as is instantly claimed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, the term "cogener", where not further defined by a structural formula or chemical name, to particularly point out the identity of compound with analogous activity or structure, renders the claim in which it occurs indefinite.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Bergstrom et al. Patent 5,681,947.

Claims 6-8 are drawn to "contacting" an imidazoline receptor with imidazoleacetic acid ribotide, riboside or riboside cogener to regulate biological activity.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

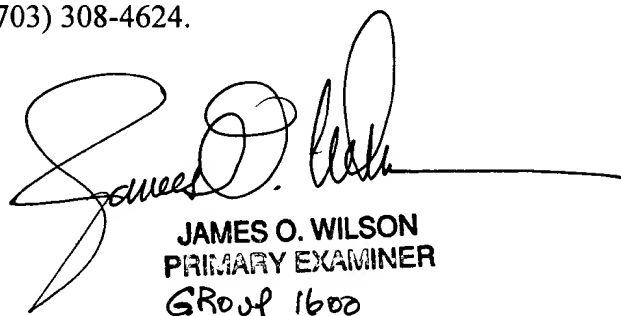
In determining the scope of the Bergstrom et al. Patent, the skilled artisan appreciates the variability of the structural core of the compound disclosed therein, see specifically column 3, lines 1 through 42, wherein the carbohydrate portion of the compound set forth in the prior art is analogous to the structure instantly claimed when the variable  $R_2$  is OH, the variable Z is Oxygen and the variable B is such that  $X_4$  and  $X_1$  are nitrogen and the remaining X variables are all carbon and the variable W is  $CO_2H$ . This generic disclosure is seen to encompass the instantly claimed compounds. The disclosure that these compounds are included into polymeric structure and are used to affect biological activities such as hybridization and binding of oligonucleotides to ambiguous nucleic acids (see column 2 , lines 42-64).

The differences between the prior art and the invention as claimed is seen to be the prior art's lack of reference to the regulation of imidazoline receptors. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to administer the instantly claimed active agents to affect biological activity because the prior art clearly indicates the skilled artisan would be quite capable of affecting biological activity. In order to establish a case of prima facie obviousness, the prior art does not have to suggest doing what applicant has done for the same purpose. In the instant case, the skilled artisan would appreciate this class of compound is recognized to affect biological activity.

Any inquiry concerning this communication should be directed to James O. Wilson,  
Primary Examiner in Art Unit 1623 at telephone number (703) 308-4624.



JAMES O. WILSON  
PRIMARY EXAMINER  
Group 1600